

REMARKS

Applicant has considered the final office action mailed January 7, 2010, (“January 7, 2010 Office Action”) in connection with the Application. Applicant believes that the foregoing amendments, and the remarks herein, fully address the rejections of record and, accordingly, request the Examiner’s consideration thereof.

Statement of Substance of Interview held January 27, 2010

Applicant’s representative thanks Examiner O’Dell (“The Examiner”) for courtesies extended to the undersigned on the occasion of an in-person interview to discuss rejections of record, on January 27, 2010. Applicant now provides a statement of substance of the interview, as required by MPEP § 713.04.

The Applicant and the Examiner discussed possible forms of language for incorporation into the claims that delineated *in vivo* hydrolysable forms of the claimed compounds. Agreement generally was reached.

Applicant further thanks the Examiner for clarifying the reasons why the Terminal Disclaimer filed November 12, 2009 had been deemed insufficient by the Office.

Finally, Applicant’s representative also raised the propriety of making the January 7, 2010 Office action “Final”. Applicant thanks the Examiner for his willingness to work with the undersigned to identify allowable subject matter notwithstanding the after-Final status of the Application.

Amendments to the Claims

Claims 1, 6, 12, 13, and 18 are pending in the Application. Claim 13 is withdrawn from consideration.

In the instant section, it is to be assumed that reference herein to a single portion of the specification in support of a particular amendment or new claim, is not to preclude the existence of additional support for that amendment or claim, but located elsewhere in the specification and drawings, and not specifically referenced herein.

Claims 1, 12, and 18 are amended herein to recite certain *in vivo* hydrolysable esters, as found at least on page 13 of the Application as filed (reference is made to WO 02/020710, the

publication of international application serial no. PCT/GB02/03983, of which the Application is the U.S. national phase).

Accordingly, no new matter is introduced by way of the amended claims herein, and entry thereof is respectfully requested.

Information Disclosure Statement

Applicant submits concurrently herewith an information disclosure statement. The Examiner's consideration of the references listed in connection therewith, and his acknowledgment of the same is hereby requested.

REJECTIONS OF THE CLAIMS

Applicant thanks the Examiner for withdrawing prior rejections under 35 U.S.C. § 103(a), and 35 U.S.C. § 112 (1st paragraph) regarding scope of enablement.

Rejections under 35 U.S.C. § 112 (¶ 2)

The Examiner has rejected claims 1, 6, 12, and 18 under 35 U.S.C. § 112 (second paragraph) as allegedly being indefinite for reciting the term “*in vivo* hydrolysable ester or amide”. Per Applicant's remarks hereinabove, and the interview between the Examiner and the undersigned, Applicant believes that the instant claim amendments address this ground of rejection in full.

Accordingly, Applicant respectfully requests that the rejection of record be withdrawn.

Double Patenting Rejection

The Examiner has rejected claims 1, 6, 12, and 18 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent Application No. 7,192,946. Applicant had previously filed a Terminal Disclaimer, on November 12, 2009, in an effort to address this rejection in full. The Office has indicated that the Disclaimer was not “approved”. Applicant thanks the Examiner for clarifying, at interview, that the source of insufficiency in the previously-filed Terminal Disclaimer was the lack of a statement establishing the assignee's extent of ownership in the Application.

Inventor(s) : Ingemar Starke et al.
Serial No. : 10/546,005
Filed (371(c)): August 18, 2005
Page : 10 of 10

Attorney Docket No.: 23854-0005US1

Accordingly, Applicant files herewith a Terminal Disclaimer under 37 C.F.R. §1.321(c), revised to show that the assignee is owner of a 100% interest in the application, thereby addressing the rejection in full. Accordingly, withdrawal of the rejection is therefore requested.

Nevertheless, Applicant notes again that a Terminal Disclaimer is being filed merely for the purpose of expediting allowance of the instant application. Applicant respectfully submits that the filing of a Terminal Disclaimer in the instant application is not to be taken as an acknowledgment of the propriety of the rejection, or an admission of obviousness of any of the instant claims over those of U.S. Patent No. 7,192,946. *See Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870 (Fed. Cir. 1991) (holding that filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the proprietary of the rejection); *see also Motionless Keyboard Co. v. Microsoft Corp.*, 486 F.3d 1376, (Fed. Cir., 2007) (holding that a terminal disclaimer is not a concession of obviousness).

CONCLUSION

In view of the above remarks, Applicant respectfully submits that the subject application is in good and proper order for allowance. Withdrawal of the Examiner's rejections and early notification to this effect are earnestly solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 839-5070.

No fee is believed owed in connection with filing of this amendment and reply. However, should the Commissioner determine otherwise, the Commissioner is authorized to charge any underpayment or credit any overpayment to Fish & Richardson P.C. Deposit Account No. 06-1050 (ref. no. 23854-0005US1) for the appropriate amount.

Respectfully submitted,

Date: March 30, 2010 By: /Richard G. A. Bone/ 56,637
Richard G. A. Bone (Reg. No.)

Customer Number 26181
Fish & Richardson P.C.
Telephone: (650) 839-5070
Facsimile: (650) 839-5071